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EXAMINER	
ROSEN, NICHOLAS D	
ART UNIT	PAPER NUMBER
3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/015,258	GRAFF, RICHARD A.	
	Examiner	Art Unit	
	Nicholas D. Rosen	3625	

-- The MAILING DATE of this communication appears on th cover she t with th correspondence address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 March 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claims 1-27 have been examined.

Examiner has noted the Applicant's request for an Interference against Harrington et al., U.S. Patent 6,161,099. However, Examiner does not believe that an Interference is proper, because, as set forth below, Examiner believes that the instant application does not adequately support the claim limitations; and that the earlier applications, of which the instant application is a continuation-in-part (via intermediate applications of which the instant application is a continuation), which predate Harrington's filing date, definitely do not provide adequate support for the claim limitations. Therefore, Examiner has judged it proper to reject Applicant's claims based on Harrington.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it is 216 words long, exceeding the 150 word limit. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: On page 11, line 8, "almost never not be large enough" should be "almost never be large enough". On page 34, lines 9-10, "Financial Analysis Output 26" should be "Financial Analysis Output 24", to be compatible with Figure 2, and with line 8 on page 34. On page 34, line 12, "Input Data A 70" should "Input Date A 70" to be compatible with Figure 4B; similarly, on page 34, line 13, "Input Data B 72" should be "Input Date B 72".

Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claims 2, 14-17, and 19-27 are objected to because of the following informalities: In the third line of claim 2, "said multiple buyers' computer" should be "said multiple buyers' computers"; in the seventh line of claim 2, "instruments comprising" should be "instruments, said electronic bidder process comprising". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-13, and 18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As per claim 1, the instant application does not disclose an electronic bidder process for selling fixed income instruments. (Applicant refers to page 13, lines 22-24, and other portions of the specification, but none of them describes a bidding or auctioning process.) The instant application does not disclose inputting data associated with at least one price the buyer is willing to pay for at least one fixed income instrument into a buyer's computer via input means. (The Applicant refers to page 29, lines 3-12, and page 30, lines 4-8, as supporting this limitation, but these parts of the specification teach computing a price that it is expected that buyers will be willing to pay, based on prevailing interest rates, etc., in a financial analysis computer system, rather than inputting the price a particular buyer is willing to pay, or even data associated therewith, into a buyer's computer; in fact, the calculated data is outputted *to* at least one buyer's computer [page 55, lines 10-18; Figure 6].) The instant application does not disclose presenting said price by outputting at least some of said inputted data from said buyer's computer over said multiple computer system. (The Applicant refers to page 34, lines 8-10, and page 24, line 23, in support of this limitation, but while the language of the specification at those points refers to presenting data, the data is not "said price," nor from the buyer's computer; instead, the data is financial analysis output data sent *to* at least one buyer's

computer.) A fortiori, support for these claim limitations is definitely not present in the specification of U.S. Patent 5,802,501, filed January 12, 1994, of which the instant application is (via intermediate applications) a continuation-in-part.

Claims 3-13 and 18 are rejected as depending on claim 1.

Claims 2, 14-17, and 19-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As per claim 2, the instant application does not disclose an electronic bidder process for selling fixed income instruments. (Applicant refers to page 13, lines 22-24, and other portions of the specification, but none of them describes a bidding or auctioning process.) The instant application does not disclose, at one of multiple buyers' computers, inputting data associated with a price one of the multiple buyers is willing to pay for fixed income instruments into via respective input means. (The Applicant refers to page 29, lines 3-12, and page 30, lines 4-8, as supporting this limitation, but these parts of the specification teach computing a price that it is expected that buyers will be willing to pay, based on prevailing interest rates, etc., in a financial analysis computer system, rather than inputting the price a particular buyer is willing to pay, or even data associated therewith, at a buyer's computer; in fact, the calculated data is outputted *to* at least one buyer's computer [page 55, lines 10-18; Figure 6]). The instant application does not disclose presenting said price by outputting said yield/discount rate over said multiple computer system to said other computer. (The Applicant refers to page 24, line

23, and page 60, lines 19-20, in support of this limitation, but at page 60, lines 19-23, the specification teaches calculating a yield/discount rate at a seller computer system, rather than outputting said yield/discount rate computed based at least in part on data associated with a price a buyer is willing to pay.) A fortiori, support for these claim limitations is definitely not present in the specification of U.S. Patent 5,802,501, filed January 12, 1994, of which the instant application is (via intermediate applications) a continuation-in-part.

Claims 14-17 and 19-27 are rejected as depending on claim 2.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 14-17, and 19-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the transmitting step" in the seventeenth (next to last) line. There is insufficient antecedent basis for this limitation in the claim. "The transmitting step" is presumed for examination purposes to refer to the outputting step.

Claims 14-17 and 19-27 are rejected as depending on claim 2.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 recites the limitation "said communicating step" in the third line. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-13, and 18

Claims 1, 3-13, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington et al. (U.S. Patent 6,161,099) in view of official notice. As per claim 1, Harrington discloses in an electronic bidder system including a second computer having an output means and at least one buyer's computer having an input means and a monitor, said buyer's computer and said second computer being respectively located, said computers being used in cooperation in a multiple computer system in electronically communicating data between said computers, an electronic bidder process for selling fixed income instruments (Abstract; Figure 1), the process comprising: inputting data associated with at least one price the buyer is willing to pay for at least one fixed income instrument into said buyer's computer via said input means (column 4, lines 34-46; column 5, lines 11-36; column 6, lines 11-52; Figure 1); automatically computing a yield/discount rate based at least in part on said inputted data, said automatically computed yield/discount rate associated with said at least one

fixed income instrument (column 8, lines 18-28; column 9, lines 23-55; Figures 10 and 11); presenting said price by outputting at least some of said inputted data from said buyer's computer over said multiple computer system (column 4, lines 34-46; column 5, lines 11-39; column 11, lines 20-48; Figure 3a); communicating data associated with said price to said second computer over said multiple computer system (Abstract; column 4, lines 34-46; column 5, lines 11-39; column 11, lines 20-48). Harrington does not expressly disclose that the input means is electrically coupled, but official notice is taken that it is well known for keyboards, computer mice, etc., to be electrically coupled to computers. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the input means electrically coupled to the at least one buyer's computer, for the obvious advantage of enabling the buyer or buyers to input data using standard, widely available equipment.

As per claim 3, Harrington discloses that said presenting step includes presenting a price a buyer is willing to pay for at least one of an entire fixed income instrument and a component of the fixed income instrument (column 6, lines 20-25; column 9, lines 23-65).

As per claim 4, Harrington discloses that said system further includes a third computer respectively located in said multiple computer system, and said presenting step comprises outputting said data from said buyer's computer, and said third computer receiving said data, by electronic communication (Abstract; Figure 3a; column 4, lines 47-55; column 11, lines 20-41).

As per claim 5, Harrington discloses that his invention is applicable to Treasury auctions (column 6, lines 14-17). Harrington does not expressly disclose inputting an interest rate for at least one maturity associated with at least one fixed income Treasury instrument including one or more series of maturities, but does disclose inputting an interest rate for at least one maturity associated with at least one fixed income instrument including one or more series or maturities (column 4, lines 34-46; column 5, lines 11-36; column 6, lines 11-52; column 9, lines 4-11 and 23-39; Figure 10), and discloses that his invention is applicable to Treasury auctions (column 6, lines 14-17). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to apply Harrington's invention to at least one fixed income Treasury instrument, for the obvious advantage of applying Harrington's method to one of the financial instruments for which he declares it applicable, thus making Treasury auctions more convenient.

As per claim 6, Harrington discloses inputting a purchase price for one of a component of a portfolio of fixed income instruments and all of the portfolio of fixed income instruments (column 9, lines 23-65; column 10, lines 22-23).

As per claim 7, Harrington discloses that said inputting step includes inputting a yield/discount rate for each maturity associated with a portfolio of fixed income instruments (column 4, lines 34-46; column 5, lines 11-36; column 6, lines 11-52; column 9, lines 4-11 and 23-55; Figures 10 and 11), and discloses that his invention is applicable to Treasury auctions (column 6, lines 14-17). Harrington does not expressly disclose that the instruments are associated with a Treasury yield curve, but official

notice is taken that Treasury yield curves are well known, so Treasury instruments are inherently associated with a Treasury yield curve. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the inputting step include inputting a yield/discount rate for each maturity associated with a portfolio of fixed income Treasury instruments, for the obvious advantage of applying Harrington's method to one of the financial instruments for which he declares it applicable, thus making Treasury auctions more convenient.

As per claim 8, Harrington discloses that the system further includes a third computer respectively located in said multiple computer system, and said process further includes at least some of said data inputted by said inputting step being received by electronic communication by said third computer in said multiple computer system for display (Abstract; Figure 3a; column 4, lines 47-55; column 11, lines 20-41). Harrington does not expressly disclose that said third computer has a monitor, or that said data is displayed on said third computer's monitor, but official notice is taken that it is well known for computers to have monitors (as Harrington shows in Figure 1). Hence it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the third computer to have a monitor, and for at least some of the data to be displayed on the third computer's monitor, for the obvious advantage of enabling the user of the third computer to easily view the data, and any other data on the third computer.

As per claim 9, Harrington discloses that bidders can view bid information in real-time (column 4, lines 47-55; column 12, lines 46-58; column 13, 21-25), implying that

receipt of electronically communicating data by said third computer is performed in real time response to said presenting step. Harrington illustrates such data including at least text (Figure 6).

As per claim 10, Harrington discloses that bidders can view bid information in real-time (column 4, lines 47-55; column 12, lines 46-58; column 13, 21-25), implying that said communicating step is performed in real time response to said presenting step.

As per claim 11, Harrington discloses that the computing step comprises computing the yield/discount rate (column 9, lines 23-55).

As per claim 12, Harrington discloses receiving at least some output by said buyer's computer in the multiple computer system communicated from a second other computer in the multiple computer system, said buyer's computer and said second other computer respectively located, and at least some of said output including an offering memorandum (Abstract; Figure 3a; column 4, lines 47-55; column 11, lines 20-41).

As per claim 13, Harrington discloses automatically verifying said inputted data (column 4, lines 56-67).

As per claim 18, Harrington discloses inputting an interest rate for at least one maturity associated with at least one fixed income instrument including one or more series of maturities (column 4, lines 34-46; column 5, lines 11-36; column 6, lines 11-52; column 9, lines 4-11 and 23-39; Figure 10), and discloses that his invention is applicable to Treasury auctions (column 6, lines 14-17). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the inputting step include inputting an interest rate for at

least one maturity associated with at least one fixed income Treasury instrument including one or more series of maturities, for the obvious advantage of applying Harrington's method to one of the financial instruments for which he declares it applicable, thus making Treasury auctions more convenient.

Claims 2, 14-17, and 19-27

Claims 2, 14-17, and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington et al. (U.S. Patent 6,161,099) in view of official notice. As per claim 2, Harrington discloses in an electronic bidder system including multiple buyer's computers and an other computer, the multiple buyers' computers and the other computer respectively located, each of said multiple buyers' computers having a respective input means and monitor, said other computer having an output means, said computers being used in cooperation in a multiple computer system in electronically communicating data between said computers, an electronic bidder process for selling fixed income instruments, comprising: at one of said multiple buyers' computers, inputting data associated with a price one of the multiple buyers is willing to pay for fixed income instruments via said respective input means (column 4, lines 34-46; column 5, lines 11-36; column 6, lines 11-52; Figure 1); automatically computing a yield/discount rate based at least in part on said inputted data, said automatically computed yield/discount rate associated with said fixed income instruments (column 8, lines 18-28; column 9, lines 23-55; Figures 10 and 11); outputting said yield/discount rate over said multiple computer system to said other computer (Abstract; column 9, lines 23-55; Figures 10 and 11); and displaying said yield/discount on said other computer's output

means (Figure 3a; column 11, lines 20-48). Harrington does not expressly disclose that the respective input means and monitor are electrically coupled, but official notice is taken that it is well known for monitors, keyboards, computer mice, etc., to be electrically coupled to computers. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the input means and monitors electrically coupled to the respective buyers' computers, for the obvious advantage of enabling the buyers to input data and observe output using standard, widely available equipment.

Harrington does not expressly disclose that at least one of the inputting step and the outputting step is performed using a computer program for receiving data from said multiple computer system, but official notice is taken that it is well known for computers to use programs for inputting and outputting data. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have at least one of the inputting step and the outputting step be performed using a computer program for receiving data from said multiple computer system, for the obvious advantage of enabling data to be inputted and outputted conveniently, without resorting to such improbable expedients as having a human operator input and output it in Morse code.

As per claim 14, Harrington discloses that said displaying step comprises displaying said yield/discount rate (Figure 3a; column 11, lines 20-48; column 13, lines 11-14).

As per claim 15, Harrington discloses selling the fixed income securities to the one of said multiple buyers first presenting the most favorable price at least one of the multiple buyers is willing to pay (column 14, lines 14-16).

As per claim 16, Harrington discloses selling the fixed income securities to the buyer presenting said price said buyer is willing to pay (Abstract; column 4, lines 34-46).

As per claim 17, claim 17 is parallel to claim 4, and rejected on similar grounds.

As per claim 19, claim 19 is parallel to claim 6, and rejected on similar grounds.

As per claim 20, claim 20 is parallel to claim 7, and rejected on similar grounds.

As per claim 21, claim 21 is parallel to claim 8, and rejected on similar grounds.

As per claim 22, Harrington discloses presenting at least one price at least one of the multiple buyers is willing to pay based on the inputting step (column 4, lines 34-46; column 5, lines 11-39; column 11, lines 20-48; Figure 3a), and discloses that bidders can view bid information in real-time (column 4, lines 47-55; column 12, lines 46-58; column 13, 21-25), implying that receipt of electronically communicating data by said second other computer is performed in real time response to said presenting step. Harrington illustrates such data including at least text (Figure 6).

As per claim 23, Harrington discloses presenting at least one price at least one of the multiple buyers is willing to pay based on the inputting step (column 4, lines 34-46; column 5, lines 11-39; column 11, lines 20-48; Figure 3a), and that bidders can view bid information in real-time (column 4, lines 47-55; column 12, lines 46-58; column 13, 21-25), implying that the communicating step is performed in real time response to said presenting step.

As per claim 24, claim 24 is parallel to claim 11, and rejected on similar grounds.

As per claim 25, claim 25 is parallel to claim 12, and rejected on similar grounds.

As per claim 26, claim 26 is parallel to claim 13, and rejected on similar grounds.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Related U.S. patents 5,802,501, 6,167,384, and 6,192,347, all to Graff (the instant Applicant) are made of record as of interest for what is and is not disclosed in the specifications, and for what was and was not allowed in the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and for After Final communications. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Nicholas D. Rosen
December 28, 2002